

REMARKS

I. The Standard for Requiring Restriction Has Not Been Met

The restriction requirement is improper on its face because it does not meet the minimum required standard set forth in MPEP §803. Section 803 requires two criteria for a proper requirement of restriction for purported patentably distinct inventions. First, the inventions must be independent or distinct as claimed. Second, regardless of whether the inventions are independent or distinct, there "must be a *serious burden* on the examiner if restriction is required." (emphasis added) Referring to the second requirement, §803 recites that "if the search or examination of an entire application can be made *without serious burden*, the examiner *must examine it on the merits*, even though it includes claims to independent or distinct inventions." (emphasis added)

There is no evidence in the record that search and examination of the entire application would be any burden, much less a serious burden, on the examiner, as is necessary for upholding a proper restriction requirement. There is absolutely no burden on the examiner to search for the different groups, because both groups need to be searched simply to properly examine the independent claims. Furthermore, both of the groups belong to the exact same class (705) and subclass (26). Because the search and examination of the entire application can be made without serious burden on the examiner, it is wasteful of time, effort, and resources for both the Applicants and the Patent Office to prosecute the claims in separate applications. Search and examination of all claims together in this application would be much more efficient than requiring both the Patent Office and the Applicants to do so separately in multiple applications.

The Applicants therefore traverse the restriction requirement on the grounds that the minimum standard for a restriction requirement as set forth in MPEP §803 has not been met. The restriction requirement should be withdrawn and all of claims 1-16 searched and examined in the present application. Such action is hereby respectfully solicited.

II. Effect of Improperly Upholding the New Restriction Requirement

The effect of the Patent Office upholding the improper restriction requirement is that the Patent Office admits that the claims of, for example, Group I are patentably distinct over the claims of Group II. MPEP §802.01 states that distinctness for a restriction requirement

means that two or more subjects as claimed "ARE PATENTABLE (novel and unobvious) OVER EACH OTHER." (emphasis in original) The effect of upholding the restriction requirement is that the Patent Office admits that the claims of the elected groups are patentable over any disclosure of the claims of the non-elected groups, and vice versa.

The patentability position is required for entry of the restriction requirement by the Patent Office. Thus, if the restriction requirement is upheld, the applicants can and will rely upon this position during examination of this application and any continuing or divisional applications. If this position is not to be taken by the Patent Office, then the applicants request that the restriction requirement be withdrawn.

III. Provisional Election

The applicants *provisionally elect*, as required for a complete response, claims associated with the embodiment alleged to be Group II (claims 9-16) by the examiner. Non-elected claims are indicated as "withdrawn" in the above listing. Applicants do not abandon the subject matter disclosed in the withdrawn claims and retain the right to pursue this subject matter in continuation and/or divisional applications. The applicants make this provisional election *with traverse* in accordance with the foregoing remarks.

CONCLUSION

Reconsideration and withdrawal of the restriction requirement is solicited for the foregoing reasons. As a result, consideration and examination of all of claims 1-16 pending in the application is further solicited. No fees are believed to be due. However, if there are any additional fees or refunds required, the Commissioner is directed to charge or credit Deposit Account No. 13-2855 of Marshall, Gerstein & Borun LLP. A copy of this paper is enclosed herewith.

Should the examiner wish to discuss the foregoing or any matter of form in an effort to advance this application toward allowance, the examiner is invited to telephone the undersigned at the below-listed number.

Appl. No. 09/715,872
Amdt. dated June 13, 2005
Reply to Office action of May 13, 2005.:

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Respectfully submitted,

By 

Randall G. Rueth

Registration No.: 45,887

MARSHALL, GERSTEIN & BORUN LLP

233 S. Wacker Drive, Suite 6300

Sears Tower

Chicago, Illinois 60606-6357

(312) 474-6300

Attorney for Applicant